

BEST AVAILABLE COPY



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

KD

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
022249-150	04/07/98	CLARY	D 233/187

022249
LYON AND LYON LLP
SUITE 4700
633 WEST FIFTH STREET
LOS ANGELES CA 90071-2066

HM22/1014

EXAMINER	
BASI, N	
ART UNIT	PAPER NUMBER
1646	9

DATE MAILED: 10/14/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 09/057,150	Applicant(s) CLARY, DOUGLAS
Examiner Nirmal. S. Basi	Group Art Unit 1646

Responsive to communication(s) filed on Jul 26, 1999

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1, 6-8, 10, 11, 16-18, and 20-26 is/are pending in the application.

Of the above, claim(s) 1, 6-8, 10, 11, 16-18, and 20-22 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 23-26 is/are rejected.

Claim(s) _____ is/are objected to.

Claims 1, 6-8, 10, 11, 16-18, and 20-26 are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 4 and 6

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. Amendment filed 7/30/99 has been entered.

5

Election/Restriction

2. Applicant's election with traverse of Group III (Claims 23-26), in Paper No. 8 (7/30/99), is acknowledged. The traversal is on the ground(s) that it would not be a serious burden to examine Groups I and II together with Group III because claims 2-5, 9, 12-15 and 19 have been canceled, claim 1 amended to incorporate the subject matter of claims 2-5, claim 11 amended to incorporate the subject matter of claims 12-15, the amended claims now recite that the claimed method must be practiced with a chimera comprising an extracellular region of RET and an intracellular region of C-RET and a search with respect to the amended claims and elected Group would require a common search for RET. This is not found persuasive because a search of groups I-III would not be co-extensive particularly with regard to the literature search. The methods of Groups I-III are distinct because they are independent, using separate method steps, active agents and having different effects. An examination of the materially different, patentably distinct inventions in a single application would constitute a serious undue burden on the examiner. Claims 6-8, 10, 16-18, 20-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

15

20 The requirement is still deemed proper and is therefore made FINAL.

Claim Rejection, 35 U.S.C. 112

3. Claims 23-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as
5 the invention.

Claims 23 is indefinite because it is unclear what is the “effect on said cells” and therefore it is unclear how the effect is “monitored” so as to allow metes and bounds of the claims to be determined.

Claims 24 is indefinite because it is unclear what type of change in phenotype is being
10 monitored so as to allow metes and bounds of the claims to be determined.

Claims 25 is indefinite because it is unclear what is the “catalytic activity” and therefore is unclear how the “change or an absence of a change” in said “catalytic activity” is monitored so as to allow metes and bounds of the claims to be determined.

Claims 26 is indefinite because it is unclear what is the “interaction” and therefore is
15 unclear how the “change or an absence of a change” in said “interaction” in said is monitored so as to allow metes and bounds of the claims to be determined. Further it is not clear what is a “natural binding partner” so as to allow metes and bounds of the claims to be determined. The structural and functional limitations of said “natural binding partner” are not provided.

Art Unit: 1646

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

5 (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 23-26 rejected under 35 U.S.C. 102(a) as being anticipated by Trupp et al. (IDS Ref AQ). Trupp et al. disclose: a) expression of C-RET in cells, see page 786, Fig. 2,

“METHODS” section; b) contacting cells with one or more compounds ie. GDNF, see page 786, Fig. 2, “METHODS” section; c) monitoring an effect on said cells ie. cell survival and growth,

10 see page 786, Fig. 2, “METHODS” section. Ret is a functional receptor for GDNF, ie natural binding partner, see page 786, Fig 1. Change in the interaction between C-RET receptor and natural binding partner is disclosed in Fig. 2 and page 788, third paragraph. The catalytic activity of C-RET is disclosed in Fig 1, ie. “Ret tyrosine phosphorylation”. Measurement of cell phenotype is disclosed in Fig 4. The disclosure of Trupp et al. meets the limitations of Claims

15 23-26.

5. Claims 23, 24 and 26 rejected under 35 U.S.C. 102(a) as being anticipated by Durbec et al. (IDS Ref AE). Durbec et al. disclose: a) expression of C-RET in cells, see Fig. 2 and Fig 4,

b) contacting cells with one or more compounds ie. GDNF, see Fig. 2 and Fig 4, c) monitoring an effect on said cells ie. cell phenotype, see Fig. 2 and Fig 4. The disclosure of Durbec et al.

20 meets the limitations of Claims 23, 24 and 26.

Art Unit: 1646

No claim is allowed.

Advisory Information

5 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirmal Basi whose telephone number is (703) 308-9435. The examiner can normally be reached on Monday-Thursday from 9:00 to 5:30.

10 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310. The fax phone number for this Group is (703) 308-0294.

15 Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Nirmal S. Basi
Art Unit 1646
October 8, 1999

20

Elizabeth C. Kemmerer

ELIZABETH KEMMERER
PRIMARY EXAMINER